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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,977	12/11/2003	Mateen Jamil Greenway	50-03-022	8545

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EXAMINER

LEVINE, ADAM L

ART UNIT PAPER NUMBER

3625

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,977

Applicant(s)

GREENWAY, MATEEN JAMIL

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant filed a reply dated March 31, 2006, in response to the office action mailed December 29, 2005. In the response, applicant has submitted no claim amendments. Applicant has provided arguments in support of the originally filed amendments. Applicant's arguments are herein addressed.

Response to Arguments

Applicant's arguments filed March 31, 2006, have been fully considered but they are not persuasive. Applicant argues that the prior art does not teach or suggest providing services within an enterprise common operating environment. Applicant's specification describes the services being provided within an enterprise common operating environment where the enterprise is a company, government, school, or other similar enterprise. Essentially, this means within a network operating within an organization, i.e., an intranet or private network. However, the specification also describes the network in which the invention can be implemented as including both public and private networks. This blurs the distinction if there is one that would prevent the present invention or anything similar from operating on either a public or private network. Additionally, the present specification and claims discuss providing a service within an enterprise common operating environment but do not disclose any element that would require the present invention to be completely enclosed within such an

environment. It is merely the particular specified services that are provided in said environment. In this context the environment is not limiting, and is therefore not a patentably distinct limitation.

The prior art also teaches use within both public and private networks, as well as hybrid networks (column 1 lines 34-36, column 2 lines 49-56, column 7 lines 11-16, column 19 line 58 – column 20 line 4). Far from teaching away, the prior art teaches use in a range of operating environments, much the same as the present application. An inventive aspect of the prior art is its teaching of providing services over a public (untrusted) network that rise to the same trusted level as those provided within an enterprise common operating environment. This does not preclude its use in an enterprise common operating environment, an option that is also disclosed in the prior art. If anything it teaches that providing services in such an operating environment was not only disclosed in the prior art, but was also old and well known at the time of the invention disclosed in the prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Teper (Paper # 051222; US Pat. No. 5,815,665).**

Teper teaches all the limitations of Claims 1-21. For example, Teper discloses methods and systems for providing services to users over a distributed network with both client and server based applications (see at least abstract, Fig.1). Teper further discloses:

- sending a list of available services to be displayed to a user: the list including pricing information for at least some available services (see at least Fig.1, column 4 lines 15-27, column 8 lines 59-62, column 12 lines 24-29); wherein the services include local applications or server-based applications (see at least abstract, Figs.1,3,4, column 7 lines 44-47 column 11 lines 34-53, column 13 lines 17-29, column 14 lines 53-61); wherein the list of available services is customized to the user's role within the enterprise (see at least column 4 lines 22-24, column 5 lines 49-55, column 12 lines 24-29)
- receiving a user selection of a service: wherein the user can thereby select only required services to use within a common operating environment (see at least column 4 lines 15-25, column 12 lines 24-29, column 15 lines 35-45).
- providing the selected service to the user: in an enterprise common operating environment (see at least abstract, column 1 lines 13-23, 34-36; column 6 lines 53-61, column 11 lines 32-33).
- creating a billing record: indicating the selected service and the user wherein each service can be individually selected and billed to the user, and wherein the services are billed to the user's business unit (see at least column 3 lines 32-45, column 4 lines 25-27, 36-40, column 5 lines 38-44, column 6 lines 46-49, column

7 lines 35-37. Please note: There is no functional distinction between billing the user and billing the user's business unit, it therefore will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); In any case, the prior art is not limited to one or the other definition, see at least column 7 lines 1-16.)

- storing the user selection: (see at least column 1 lines 17-22, column 3 lines 34-36, column 3 line 65 – column 4 line 14, column 6 lines 27-33, 53-61, column 8 lines 12-19).
- a processor and accessible memory: (see at least claim 45, column 26 lines 40-46)

Pertaining to machine readable computer program product Claims 15-21

Rejection of Claims 15-21 is based on the same rationale as noted above.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert M. Pond can be reached on 571.272.6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
June 12, 2006



Primary Examiner